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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,196	07/25/2005	Kai Desinger	3254	5577
21834 7590 09/10/2009 BECK AND TYSSER P.L.L.C. 2900 THOMAS AVENUE SOUTH SUITE 100 MINNEAPOLIS, MN 55416				
EXAMINER				
HOLMES, REX R				
ART UNIT		PAPER NUMBER		
3762				
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09/10/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/518,196

Applicant(s)

DESINGER ET AL.

Examiner

REX HOLMES

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 8-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date 3/27/09

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8, 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 8 recites, "wherein the marker element is in the form of a coating...", this claim is conflicting as the independent claim states that the marker element is a wire. It is unclear how the wire is just a coating.
4. Claims 9 recites, "wherein the marker element is in the form of a wire" in line 5 and "the marker element is in the form of a coating" in line 7. This claim is conflicting as the claim states that the marker element is in the form of a wire and in the form of a coating. The specification is silent as the device having multiple marker elements.
5. Claims 10 recites, "wherein the marker element is in the form of a wire" in line 5 and "the marker element is in the form of a coating" in line 9. This claim is conflicting as the claim states that the marker element is in the form of a wire and in the form of a coating. The specification is silent as the device having multiple marker elements.
6. Claim 13 recites, "wherein the marker element is in the form of a wire coil". This claim is conflicting as the independent claim states that the marker element is in the form of a wire and then claim 13 states that the marker element is in the form of a wire

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coating. The specification is silent as the device having multiple marker elements. It is suggested to say wherein the wire is further coiled.

7. Claim 16 recites, "wherein the element is in the form of a straight, nuclear magnetic resonance-active wire containing a ferromagnetic material. This claim is conflicting as the independent claim states that the marker element is a wire. It is suggested to say, "wherein the wire is nuclear magnetic resonance-active and contains a ferromagnetic material.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1, 3, 8, 11-13 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindgren et al. (U.S. Pat. 6,728,579 hereinafter "Lindgren") in view of Schmidt (U.S. Pub. 2002/0095202).

11. Regarding claims 1, 3, 8, 11-13 and 15-16, Lindgren discloses an electrode needle with a shaft (12), with a casing surrounding the shaft (not numbered but encompasses the area wherein the electrodes are embedded) in turn defining a lumen (24), active electrodes on the shaft (36) and a conductor (38) in the form of a conductor that is located with shaft in the wall of the casing and extending the entire length of the electrodes (Col. 4, line 47 to Col. 5, line 12; Fig. 1, "the conductor runs the entire length of the device and thus extends the entire length of the electrodes"). Lindgren further discloses that the wire can be coiled around the lumen forming a spring-like shape that acts as a sleeve (Col. 5, ll. 6-12).

12. Regarding claims 1, 3, 8, 11-13 and 15-16, Lindgren discloses an electrode needle but fails to disclose the material that the conductor is made out of and the it being a nuclear magnetic resonance marker. However, Schmidt discloses an electrode catheter that utilizes platinum or stainless steel wires as the conductors which are nuclear magnetic markers since both platinum and stainless steel are radiopaque. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the conductor as taught by Lindgren with a platinum or stainless steel wire made out of the marker material as taught by Schmidt to provide the predictable results of allowing the device to have a good reliable conductor that allows for device to be seen by imaging devices during surgery.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindgren in view of Schmidt as applied to claims 1, 3, 11-13 and 15-16 above, and further in view of Kiser et al. (U.S. Pat. 5,327,909 hereinafter "Kiser").

16. Regarding claims 8-10, Lindgren in view of Schmidt discloses the claimed invention including that the marker, but Lindgren in view of Schmidt fails to explicitly disclose that the marker is sprayed on the inside of the lumen. However, Kiser teaches that it is known to use radiopaque coatings on implantable leads and catheters to produce a visible image on the viewing screen of a magnetic resonance imaging device. It would have been obvious to one having ordinary skill in the art at the time the

invention was made to modify the marker as taught by Lindgren in view of Schmidt, with radiopaque coating as taught by Weber since such a modification would provide the device of Lindgren in view of Schmidt with a radiopaque coating that would disturb the magnetic field in a nuclear magnetic resonance field so as to produce a visible image on the viewing screen of a magnetic resonance imaging device.

17. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lindgren in view of Schmidt as applied to claims 1, 3, 11-13 and 15-16 above, and further in view of Gisselberg et al. (U.S. Pub. 2003/0052785 hereinafter "Gisselberg").

18. Regarding claims 8-10 and 12-16, Lindgren in view of Schmidt discloses the claimed invention including that the marker, but Lindgren in view of Schmidt fails to explicitly disclose that wire is coiled and tuned to the frequency of the Magnetic Resonance Imaging Device. However, Gisselberg teaches that it is known to use coiled ferromagnetic material tuned to a resonate frequency as set forth in Paragraphs 7, 8, 57, 73 and Claim 21 to provide a disturbance in the magnetic field in a nuclear magnetic resonance field so as to produce a visible image on the viewing screen of a magnetic resonance imaging device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the magnopaque marker as taught by Lindgren in view of Schmidt, with a ferromagnetic material as taught by Gisselberg since such a modification would provide the device of Lindgren in view of Schmidt with a ferromagnetic coiled marker tuned to the magnetic resonance frequency so that it would disturb the magnetic field in a nuclear magnetic resonance field so as to produce a visible image on the viewing screen of a magnetic resonance imaging device.

Response to Arguments

Applicant's arguments with respect to claims 1, 3, 8-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REX HOLMES whose telephone number is (571)272-8827. The examiner can normally be reached on M-F 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George R Evanisko/

Primary Examiner, Art Unit 3762

/R. H./

Examiner, Art Unit 3762